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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,141	01/03/2002	Radhika Aggarwal	RSW920010112US1 (007)	2419
46320 7590 11/13/2009 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487				
EXAMINER				
HUYNH, THU V				
ART UNIT		PAPER NUMBER		
2178				
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11/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/041,141

**Applicant(s)**

AGGARWAL ET AL.

**Examiner**

THU V. HUYNH

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to communications: appeal brief filed on 7/24/09, amendment filed on 4/28/08, 7/28/08 to application filed on 1/3/02.

#### **706.03(w) Res Judicata**

Res judicata may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of res judicata rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision. The timely filing of a second application copending with an earlier application does not preclude the use of res judicata as a ground of rejection for the second application claims. When making a rejection on res judicata, action should ordinarily be made also on the basis of prior art, especially in continuing applications. In most situations the same prior art which was relied upon in the earlier decision would again be applicable. In the following cases a rejection of a claim on the ground of res judicata was sustained where it was based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

In re Freeman, 30 F.3d 1459, 31 USPQ 2d 1444 (Fed. Cir. 1994). Edgerton v. Kingland, 168 F. 2d 121, 75 USPQ 307 (D.C. Cir. 1947). In re Szwarc, 319 F.2d 277, 138 USPQ 208 (CCPA 1963). In re Katz, 467 F.2d 939, 167 USPQ 487 (CCPA 1970) (prior decision by District Court). In the following cases for various reasons, res judicata rejections were reversed. In re Fried, 312 F.2d 930, 136 USPQ 429 (CCPA 1963) (differences in claims). In re Szwarc, 319 F.2d 277, 138 USPQ 208 (CCPA 1963) (differences in claim). In re Hellbaum, 371 F.2d 1022, 152 USPQ 571 (CCPA 1967) (differences in claims). In re Herr, 377 F.2d 610, 153 USPQ 548 (CCPA 1967) (same claims, new evidence, prior decision by CCPA). In re Kaghan, 387 F.2d 398, 156 USPQ 130 (CCPA 1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner "to simplify the issue," differences in claims; holding of waiver based on language in MPEP at the time). In re Craig, 411 F.2d 1333, 162 USPQ 157 (CCPA 1969) (Board of Appeals held second set of claims patentable over prior art). In re Fisher, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (difference in claims). In re Russell, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971) (new evidence, rejection on prior art reversed by court). In re Ackermann, 444 F.2d 1172, 170 USPQ 340 (CCPA

1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court). Plastic Contact Lens Co. v. Gottschalk, 484 F.2d 837, 179 USPQ 262 (D.C. Cir.1973) (follows *In re Kaghan*).

a. Board affirmed the rejections of claims 1-10 on 08/29/2007.

b. The RCE and amended claims are filed on 10/29/07. The claims have been substantially amended to require a new ground of rejections using an additional prior art reference.

b. The amendment is filed 4/28/08 comprising amended claims 1-5 having limitations exactly the same limitations of claims 1-5 respectively that have been affirmed by the Board decision. Therefore, amended claims 1-5 filed on 4/28/2008 are rejected under the ground of *Res Judicata and made final*.

d. Examiner herein vacates the office actions mailed on 7/25/2008, 10/14/2008. It is noted that the Declaration (filed on 12/21/04 and 12/05/05) are filed before the Appeal Brief (filed on 7/13/06). Thus, this Declaration is also binding with the Board decision.

The rejections affirmed by Board is included herein:

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**3. Claims 1-2, 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Upton et al., US 2003/0105884 A1, provisional filed 10/2001, in view of Jeffries et al., US 6,094,529, filed 12/1996 as supplied by the Applicants in IDS filed 01/03/2002, and “Instant HTML”, Homer et al., copyright 1997, pages 88-101.**

**Regarding independent claim 1**, Upton teaches the steps of:

- detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form (Upton, col.5, paragraph 62; user fill-out data and submits an html form, validating data in submitted form to detect invalid data);
- inserting a row in said markup specified form in a position which is proximate to said input element (Upton, col.5, paragraph 62, redisplaying the form with error message next to each erroneous field. This inherently disclose inserting a text row next to erroneous field in the html form);
- selecting error text corresponding to said validation error and inserting said selected error text in said row (Upton, col.5, paragraph 62, redisplaying the form with error message next to each erroneous field); and
- serving said markup specified form in a response to said form-based submit (Upton, col.5, paragraph 62).

Upton does not explicitly disclose that said row having a background color which differs from other colors which is visible in proximity to said inserted row; inserting an anchor tag in said markup specified form in a position which is proximate to said input element; and in a response to said form-based submit, said response referring said anchor tag.

Jeffries teaches error message is highlighted, such as by underlining, changing the background color to provide a visual indicator (Jeffries, col.3, lines 33-36 and col.5, lines 24-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Jeffries' visual indicator in error message into Upton's error message in html form to insert error text message having a background color which differs from other colors which is visible in proximity to said insert error text, since this would have provided a visual indicator for the user to focus on erroneous field in the html form. It is also noted that highlighting error data or error text field in an html form as a visual indicator for the user re-entries the data was well known in the art at the time the invention was made.

Homer teaches including an anchor within a page so that, when we load the page, that part of the document is automatically scrolled into view (Homer, page 88, "Anchors Within A Page" section; placing the anchor tag with name "dalmation" in section Dalmatians to directly scroll to that section when the page dog.html is loaded).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Homer's teaching into Upton's redisplay form to insert an anchor tag in the html form in a position which is proximate to said input element, since this would have allowed when the user submit the html form, error part of the html form is

automatically scrolled into view Homer's disclosed above for the user enter a correct data as. This would have facilitated the user to re-enter the data when the error field is directly provided.

**Regarding claim 2**, which is dependent on claim 1, Upton does not explicitly disclose inserting an error image adjacent to said input-element.

Jeffries teaches insert a glyph near highlighting text error message to provide a visual indicator (Jeffries, col.3, lines 33-36 and col.5, lines 24-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Jeffries' glyph visual indicator in error message into Upton's error message in html form to insert a image/glyph near the error text message, since this would have provided a visual indicator for the user to focus on erroneous field in the html form.

**Regarding claim 5**, which is dependent on claim 4. Refer to the rationale relied to reject claim 1, Upton, Jeffries and Homer teach inserting an anchor tag in said markup specified form in a position which is proximate to said input element. Homer also teaches the anchor tag place before the section to be automatically displayed (Homer, page 97, "Using Anchors in Your Pages" section).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Homer's teaching into Upton's redisplay form to insert an anchor tag in the html form in a position which is proximate but before to said input element, since placing the anchor tag before the error section would have allowed the error part of the

html form is automatically scrolled into view as Homer's disclosed above for the user enter a correct data as. This would have facilitated the user to re-enter the data when the error field is directly provided.

**4. Claims 3-4 remain rejected and newly claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Upton in view of Jeffries and Homer as applied to claims 1 and 6 above, and further in view of Hartman, US 6,615,226 B1, filed 09/1997.**

**Regarding claim 3**, which is dependent on claim 1, Upton, Jefferies and Homer teaches display error message proximate to said input element (error field) as explained above. However, Upton does not explicitly disclose determining whether said markup specified form contained multiple views, one of said multiple view containing said input-element and if it is determined that said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status

Hartman teaches a markup specified form contained multiple views, one of said multiple view containing said input-element (error field) (Hartman, col.9, lines 38-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hartman's teaching and Upton to includes the steps of determining said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status, since this would have allowed error message to be displayed proximity to error field in both simple or/and complex form which contains multiple view to inform error for the user re-entries, since



**Regarding claim 4**, which is dependent on claim 1, Upton, Jefferies and Homer teaches inserting an error message row in said markup specified form in a position which is proximate to said input element, said error message row having a background color which differs from other colors which are visible in proximity to said inserted row in claim 1 above. Upton does not explicitly disclose that said position is proximate to but below said input element.

Hartman teaches displaying error message in close proximity but below said input element (Hartman, col.9, lines 55-59).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Hartman and Upton to provide the error message on many different position proximate to the error input element to inform the user of error, since below or/and next is one form of proximate position.

**Regarding claim 11**, which is dependent on claim 1, refer to claim 1, the combination of Radtke, Jeffries, Hartman teaches the anchor tag is inserted after detecting the at least one validation error and prior to serving said markup specified form (Jeffries, fig.4; col.7, lines 1-16; inserting links to error messages, wherein each link is an anchor tag with “href” attribute). The rationale is incorporated herein.

#### ***Response to Arguments***

5. Applicant's arguments filed on 7/24/09 have been fully considered but they are not persuasive.

Applicants state that the rejection of claim 11 is withdrawn. Therefore, claim 11 is allowable over the prior art (Appeal Brief, Status of Claims, page 2).

However, Examiner provides rejection above, including the rejection of claim 11.

Applicants primarily argue that “The “result” of successful test is found on page 2 of Exhibit A from the First Declaration” (Appeal brief, page 5)

This is not persuasive. The disclosure document on page 2 of Exhibit A includes demonstration of error message displayed in a row bellow a user input field. However, the disclosure does not provide test results demonstrate that the test was in fact successful as the disclosure described.

Applicants primarily argue that the "due diligence was exercised between just prior to the reference date of Upton and the execution of the “Declaration and Power of Attorney for Patent Application” Appeal brief, pages 6-9)

This is not persuasive. The diligence must be proven from just prior to 10/18/2001 (the filling date of Upton reference) and end with the date of reduction to practice, either actual or constructive (applicants' filling date) 01/03/2002. Although, the applicants point out that there are three holidays in the period from 11/08/2001 to 01/03/2002, however, the diligence fails to explain activities involving to this application on this period except holidays.

Applicants primarily argue about “Six and Seventh Office Action” (Appeal brief, page 12).

However, such the "Six and Seventh Office Action" have been withdrawn/vacated.

Applicants primarily argue that "Examiner's assertion that "this Declaration is also binding with the Broad decision" is incorrect"

Examiner respectfully disagrees. All the prosecutions before Board decision are considered by Board even though there is no issue about the affidavit.

Applicants primarily argue that Upton cannot properly applied as prior art based on the Declaration.

However, the Declaration is not sufficient and the claims are still rejected.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Stephen S. Hong/  
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2178

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November 8, 2009